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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91174241
Party	Defendant William Switzer & Associates Ltd. William Switzer & Associates Ltd. #6 - 611 Alexander Street Vancouver, CA V6E 1A1
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Attachments	Opposition No. 91174241-Answer to Notice of Opposition.pdf (8 pages) (497661 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/747736
Filed on November 4, 2005
For the Mark ANDRE ARBUS COLLECTION (and DESIGN)
Published in the Official Gazette on October 31, 2006
Opposition No. 91174241

Original Arts Manufacturing Corporation :

Opposer : Opposition No. 91174241

v. :

William Switzer & Associates Ltd. :

Applicant :

ANSWER TO NOTICE OF OPPOSITION

Applicant, William Switzer & Associates Ltd ('Applicant' or 'Switzer') by its attorneys, Heslin Rothenberg Farley & Mesiti P.C., as and for its Answer to the Notice of Opposition of Original Arts Manufacturing Corporation ('Opposer') states as follows:

1. Applicant admits Paragraph 1 in so far as it relates to the date of filing of application of November 4, 2005 and publication in the Official Gazette on October 31, 2006 but denies the allegations set forth in Paragraph 1 to the extent they differ from or are inconsistent with the content of the application.
2. Applicant admits there is a pending application Serial No: 7737225, in Opposer's name, but denies having knowledge or information sufficient to

form a belief as to the truth or falsity of the allegations in Paragraph 2, and therefore denies all allegations therein.

3. Applicant denies having knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 3, and therefore denies all allegations therein.
4. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 4, and therefore denies all allegations therein.
5. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of allegations pertaining to Opposer's headquarters, and showrooms, and therefore, those allegations are denied. Applicant denies the remainder of the allegations contained in Paragraph 5.
6. Applicant admits it filed an application on November 4, 2005, and denies the remainder allegations of paragraph 6.
7. Applicant denies the allegations contained in Paragraph 7.
8. Applicant denies the allegations contained in Paragraph 8.

AS AND FOR A FIRST DEFENSE

9. Andre Arbus is the world-renowned furniture designer (1903-1969).
10. The marks ANDRE ARBUS and related marks have been continuously used as a service mark to describe the design, manufacture, and sale of furniture, and furniture related goods and services since at least as early as 1939, and prior to Opposer's use. Applicant continues to use said marks to describe these goods and services.

11. The mark has developed and enjoys extensive goodwill throughout the United States, and the world. The goodwill developed in the United States includes, but is not limited to:
- Andre Arbus's works have been the object of many sales to U.S. customers continuously since the 1930's.
 - Evidence of sales of works with the "Andre Arbus" mark to U.S. customers since at least as early as the 1970's.
 - Andre Arbus's furniture pieces were exhibited in the United States in 1939, 1949, and 1989; and several American museums currently maintain collections of signed Andre Arbus furniture pieces.
 - The Cooper-Hewitt National Design Museum in New York purchased an Andre Arbus piece in 1989.
 - Andre Arbus furniture pieces were being offered for sale and sold by auction dealers in the United States at least as early as 1992 to present.
 - Numerous magazine and newspaper articles dating back to at least January 1985 referencing Andre Arbus and Andre Arbus furniture pieces in conjunction with retail furniture galleries in the United States.
12. As a result of the expenditure of substantial sums for promotional activities, advertising, and by virtue of the excellence of Applicant's goods and services, Applicant has garnered for these marks a most valuable reputation. The mark is symbolic of the extensive goodwill and consumer recognition built up in the mark from a substantial amount of time and effort in advertising and promotion.

AS AND FOR A SECOND DEFENSE

13. The ANDRE ARBUS mark is unmistakably associated with Andre Arbus. Use of the mark suggests to those in the furniture trade as pointing uniquely and unmistakably to Andre Arbus. Opposer is not connected in any way to the activities of Andre Arbus, and Andre Arbus is of sufficient fame and reputation in the furniture trade, that connection with Andre Arbus, not Opposer, would be presumed when the Applicant's mark is used on goods and services.

AS AND FOR A THIRD DEFENSE

14. Applicant's use of the name ANDRE ARBUS comes within its right of publicity to which it has statutory and common law rights.

AS AND FOR A FOURTH DEFENSE

15. Opposer's claimed marks ANDRE and ANDRE ORIGINALS MFG. CO. are weak as they are the first name of an individual in the first case and in the second case, the name of an individual combined with descriptive terms and used, if at all, as a trade name. The marks are merely descriptive and lack acquired distinctiveness.
16. To the extent Opposer is alleging use of the word ANDRE as the mark, then the mark is weak because of multiple uses of the mark by others for similar goods and services.

AS AND FOR A FIFTH DEFENSE

17. Opposer has failed to use its mark in commerce in a manner sufficient to establish priority over the Applicant's mark.

AS AND FOR A SIXTH DEFENSE

18. There is no likelihood of confusion, mistake or deception as a result of Applicant's use of its mark because the mark is not confusingly similar to Opposer's marks alleged.

AS AND FOR A SEVENTH DEFENSE

19. The mark ANDRE ARBUS COLLECTION (and design) is distinct and distinguishable from that of Opposer's marks, and not likely to be confused with Opposer's marks.

AS AND FOR A EIGHTH DEFENSE

20. The Applicant's and Opposer's marks have co-existed for more than 16 years, while maintaining separate and distinct sponsorship, and thus are not likely to be confused.

AS AND FOR A NINTH DEFENSE

21. Applicant is seeking registration for use of the mark that is different than Opposer's use.

AS AND FOR A TENTH DEFENSE

22. Applicant's registration and use of the mark is unlikely to dilute the Opposer's mark as a source designation, since consumers and the public at large are unlikely to believe there is any association or connection between the Applicant and the Opposer.

AS AND FOR A ELEVENTH DEFENSE

23. Applicant has priority over Opposer based on the French registration for ANDRE ARBUS COLLECTION (and design), filed November 4, 2004, No.:

043,322,047, and registered April 8, 2005, No.: 05/14, Vol. II; and Canadian registration filed November 4, 2005, and registered November 7, 2005, registration No.: 1,278,485.

AS AND FOR A TWELFTH DEFENSE

24. Opposer has not sustained any damages as a result of Applicant's conduct.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE

25. The notice of opposition fails to state a cause of action upon which relief can be granted.

AS AND FOR A SECOND AFFIRMATIVE DEFENSE

26. Applicant has used its mark prior to any alleged first use date asserted by Opposer.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE

27. Opposer has failed to mitigate any alleged damages as a result of Applicant's conduct.

AS AND FOR A FOURTH AFFIRMATIVE DEFENSE

28. ANDRE ORIGINALS MFG. CO., was abandoned by Opposer as of June 16, 2004.

AS AND FOR A FIFTH AFFIRMATIVE DEFENSE

29. If, in fact, the Opposer's allegations of likelihood of confusion, which have been denied by applicant, are proven to be true, then Applicant contends that Opposer employs the use of the term ANDRE in its marks, with the intent to appropriate and trade upon the substantial goodwill and recognition that have

accrued and are associated with Andre Arbus. Use of the name ANDRE in Opposer's marks, when applied to the goods and services of the Opposer, falsely suggests a connection with Andre Arbus under the meaning of §2(a) of the Trademark Act, 15 U.S.C. 1052(a).

AS AND FOR A SIXTH AFFIRMATIVE DEFENSE

30. The relief sought by the Opposer is barred by the doctrines of laches, waiver and/or estoppel.

WHEREFORE, it is respectfully requested that the Notice of Opposition be dismissed with prejudice in its entirety and that Application serial No.78747736 proceed to registration.

Applicant Appoints HESLIN ROTHENBERG FARLEY & MESITI P.C., Susan E. Farley, Esq., David P. Miranda, Esq. and Shanna K. O'Brien, Esq., as attorneys for Applicant in connection with the above-referenced Opposition and to transact all business in the Patent and Trademark Office and in the United States Courts related to the said Opposition and to receive all official communication in connection with the Opposition.

Date: March 15, 2007

Respectfully submitted,

/s/ Susan E. Farley

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was sent via Federal Express Overnight to Opposer's counsel, Sherry H. Flax of Saul Ewing LLP at 500 E. Pratt Street, Suite 900, Baltimore, MD 21202 on this 15th day of March, 2007, and electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451.

March 15, 2007

/s/ Susan E. Farley

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